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**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 12
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Tom Koroknay

Serial No. 75/456,659

Kenneth L. Mitchell of Wooding, Krost & Rust for Tom Koroknay.

Asmat A. Khan, Trademark Examining Attorney, Law Office 104 (Sidney Moskowitz, Managing Attorney).

Before Cissel, Holtzman and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 26, 1998, Tom Koroknay (applicant) filed a trademark application to register the mark LYMAN (typed drawing) for goods identified as "Boats" in International Class 12.¹

The Examining Attorney refused to register the mark on the ground that the mark is primarily merely a surname

¹ Serial No. 75/456,659. The application alleges a bona fide intention to use the mark in commerce.

under Section 2(e)(4) of the Trademark Act. 15 U.S.C. § 1052(e)(4).

After the Examining Attorney made the refusal final, applicant filed a notice of appeal. Both applicant and the Examining Attorney have filed briefs, but applicant did not request an oral hearing.

We affirm the Examining Attorney's refusal to register.

In order to determine whether a term is primarily merely a surname, we must determine the impact the term has or would have on the purchasing public. "[I]t is that impact or impression which should be evaluated in determining whether or not the primary significance of a word when applied to a product is a surname significance. If it is, *and it is only that*, then it is primarily merely a surname." In re Harris-Intertype Corp., 518 F.2d 629, 186 USPQ 238, 239 (CCPA 1975), quoting, Ex parte Rivera Watch Corp., 106 USPQ 145 (Comm'r Pat. 1955) (emphasis in original).

The Examining Attorney submitted the following evidence to establish a prima facie case that LYMAN is primarily merely a surname. A search of the PHONEDISC Powerfinder USA One 1998 (4th ed.) returned 5199 residential listings for the name "Lyman." The first 100 listings from

"A. Lyman" through "Andrea Lyman" were printed and attached to the Examining Attorney's first Office Action.

Subsequently, the Examining Attorney also submitted ten printouts from the LEXIS/NEXIS database showing "Lyman" as a surname for people referred to in the articles. Finally, the Examining Attorney also included a page from *Merriam-Webster's Collegiate Dictionary (Unabridged)* to demonstrate that there was no listing for the term "Lyman."

Applicant responded to the Examining Attorney's refusal by including excerpts from a book entitled *The Real Runabouts, Vol. II*. Applicant submits that the book "illustrates the use of the LYMAN mark in connection with the 17 and 19 foot 'RUNABOUT' boat models as well as many other models. Further, Exhibit 'A' illustrates the historical significance of Bernard E. Lyman, (1850-1934), the company founder, citing Lyman's sale of boats for just \$24.50." Applicant's Appeal Brief, pp. 3-4. In addition, applicant submitted a copy of a registration² with his appeal brief. This registration shows that the mark LYMAN was previously registered for boats on the Principal Register under Section 2(f).³

² Registration No. 1,490,080 issued May 31, 1988. The registration was cancelled in 1994.

³ The Examining Attorney did not object to this evidence submitted with applicant's brief and, therefore, we will consider it.

Clearly, the evidence in the file supports the Examining Attorney's conclusion that the term LYMAN is primarily merely a surname. In this case, there are numerous residential phone listings for "Lyman." LEXIS/NEXIS articles show that many individuals have the last name "Lyman." Applicant has submitted evidence that the founder of the previous source of LYMAN boats was named Bernard E. Lyman. His son, Bill Lyman, was also associated with the firm. This is evidence of the surname significance of the term. In re Etablissements Darty et Fils, 759 F.2d 15, 225 USPQ 652, 653 (Fed. Cir. 1985). In addition, with over 5000 phone directory listings, LYMAN is not even arguably a rare surname. Id. (DARTY was not so unusual that the word would not be recognized as a surname by a substantial number of persons). Also, when the mark LYMAN was previously registered for boats on the Principal Register, it was registered under Section 2(f), which is appropriate for a surname.

Applicant argues that "[i]t is the longtime association of LYMAN with boats which is important." Applicant's Appeal Brief, p. 4. Even assuming that the term Lyman is still associated by the purchasing public with boats, it does not overcome a surname refusal. In a response to a similar argument that the term McDONALD'S for

restaurant services was no longer primarily merely a surname, the Board held:

In the present situation, the term "McDonald's" has no ordinary meaning other than as the possessive of a relatively common surname in the United States. The Board readily concedes that the association of "McDONALD'S" as a source indicating trademark and service mark has probably overtaken the original meaning of the word as a surname. However, this is due to the distinctiveness that has been acquired by the term over the years.

In re McDonald's Corp., 230 USPQ 304, 307 (TTAB 1986).

Similarly, any association the public would have with the term LYMAN as a prior source of boats does not eliminate the surname significance of the term. The evidence clearly supports the conclusion that the term LYMAN is primarily merely a surname. There is little, if any, evidence to the contrary.

Decision: The Examining Attorney's refusal to register the mark LYMAN on the ground that it is primarily merely a surname is affirmed.